

This Opinion is Not a
Precedent of the TTAB

Mailed: December 13, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Smith & Vandiver, Corp.

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Serial No. 88477572

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Brent Capehart of Capehart Law Firm
for Smith & Vandiver, Corp.

D. Zarick, Trademark Examining Attorney, Law Office 126,
Andrew Lawrence, Managing Attorney.

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Before Taylor, Lynch, and Lebow,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Smith & Vandiver, Corp. (“Applicant”) seeks registration on the Principal Register of the mark NATURES STAR HEMP in standard characters, with HEMP disclaimed, for:

skin and body topical lotions, creams, balms and salves for cosmetic use; all of the foregoing containing hemp oil

extract containing hemp ingredients solely derived from hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis, in International Class 3.¹

The Examining Attorney has refused registration of the mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with the mark



NATURE-STAR and design, , registered on the Principal Register for “Essential oils for aromatherapy use; Cosmetic fragrance oils; Essential oils; Essential oils for household use; Essential oils for personal use; Essential oils for use in the manufacture of scented products; Natural essential oils; Oils for cleaning purposes; Oils for toiletry purposes; Fragrances” in International Class 3.²

After the Examining Attorney made the refusal final, Applicant requested reconsideration and appealed. The case was remanded, and the Examining Attorney ultimately denied the request for reconsideration. The appeal then proceeded.

For the reasons set forth below, we affirm the refusal to register.

¹ Application Serial No. 88477572 was filed June 18, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on alleged bona fide intent to use the mark in commerce.

² Registration No. 5879275 issued on October 8, 2019 and includes the following mark description: “The mark consists of a stylized circle with the depiction of a mound of dirt with a sprout having two leaves coming out of it, the stylized wording ‘NATURES-STAR’ outside the circle following the top right corner.” Color is not claimed as a feature of the mark.

II. Likelihood of Confusion

Our determination under Section 2(d) involves an analysis of all the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). The Board considers only those *DuPont* factors for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019); *see also Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, *3 (Fed. Cir. 2020) (“Not all *DuPont* factors are relevant in each case . . .”). Two key considerations are the similarities between the marks and the relatedness of the goods. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. Similarity of the Marks

We first compare the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*,

126 USPQ2d 1742, 1746 (TTAB 2018), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012).

We compare Applicant's mark NATURE STAR HEMP to the cited mark



, and find the marks similar because of the common wording NATURES STAR and NATURES-STAR. As urged by Applicant, we compare the marks in their entirety. However, as Applicant acknowledges,³ for rational reasons, we may give more or less weight to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

Applicant contends that the cited registration's design, which it describes as a "very large, prominently displayed leaf inside a circle," should be deemed the dominant element of the mark.⁴ We find instead that the dominant portion of the

³ 6 TTABVUE 7 (Applicant's Brief).

⁴ *Id.*

cited mark rests in the wording, NATURES-STAR, that consumers would use to call for the goods. “In the case of marks ... consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *Viterra*, 101 USPQ2d at 1908; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because “[t]he word portion of a word and design mark ‘likely will appear alone when used in text and will be spoken when requested by consumers.’” *Id.* (quoting *Viterra*, 101 USPQ2d at 1911). In the cited mark, the wording also appears above the design, adding further to its prominence. *In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (greater significance attributed to the first part of a mark, which consumers notice first); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (first part of a mark “is most likely to be impressed upon the mind of a purchaser and remembered.”).

We do not find analogous the caselaw Applicant cites regarding marks with designs that dominate over wording. Despite the relatively large size of the cited mark’s design, it is a simple design, and because it is a plant in a mound of dirt, the depiction reinforces the use of NATURES in the literal portion of the mark. In addition, the cited mark’s design is not as prominent, eye-catching, and distinctive as the design elements that were deemed dominant elements in the cited caselaw. *See, e.g., In re Covalinski*, 113 USPQ2d 1166, 1169 (TTAB 2014) (“very large, prominently

displayed” letters with racing flag pattern combined with other “graphic devices ... to draw attention to the RR letters apart from the wording”); *In re White Rock Distilleries, Inc.*, 92 USPQ 2d 1282, 1284 (TTAB 2009) (“prominent design feature” and other word TERZA dominated over the smaller word VOLTA); *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1016 (TTAB 2007) (“the design is prominently displayed, being the largest element in the mark, and at the top of the mark [and] ... “the grotesque design ... is very noticeable and has the effect of catching the eye and engaging the viewer before the viewer looks at the word BODYMAN”); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 USPQ2d 1477, 1479 (TTAB 1987) (“highly stylized depiction of human frankfurters, prancing arm in arm to musical notes, creates a distinctive commercial impression.”).

Turning to Applicant’s mark, NATURES STAR forms the dominant portion of the mark. In addition to the prominence that comes from NATURES STAR appearing first in the mark, the only other word, HEMP, lacks distinctiveness for the hemp-based goods. Applicant has disclaimed HEMP, and consumers are unlikely to focus on it for source-indication. *See Detroit Ath. Co.*, 128 USPQ2d at 1050. Also adding to the similarity of the marks at issue, because Applicant has applied to register its mark in standard-character format, it could appear in the same font as the cited mark. *See Viterra Inc.*, 101 USPQ2d at 1909 (holding that the specific font style of a mark cannot serve as the basis to distinguish it from a mark in standard character form); *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) (registrant “entitled to depictions of the standard

character mark regardless of font style, size, or color”). Thus, the stylization of the cited mark cannot serve as a point of distinction.

The cited mark’s dominant element, NATURES-STAR, and Applicant’s mark’s dominant element, NATURES STAR, therefore are legally identical except for the hyphen. These elements sound the same and look nearly identical. The presence or absence of the hyphen is insignificant. *See The Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, *31 (TTAB 2019) (“The presence of the hyphen in Applicant’s mark does not distinguish it from Opposer’s mark.”) (citing *Thymo Borine Lab. v. Winthrop Chem. Co.*, 155 F.2d 402, 69 USPQ 512, 514 (CCPA 1946) (hyphen in mark THY-RIN has “no significance in speech”); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1712 (TTAB 2010) (MAGNUM without hyphen is “essentially identical” to MAG-NUM with hyphen), *aff’d mem.*, 2011 U.S. App. LEXIS 22673, 2011 WL 5400095 (Fed. Cir. Nov. 9, 2011)); *Goodyear Tire & Rubber Co. v. Dayco Corp.*, 201 USPQ 485, 488 n.4 (TTAB 1978) (“[T]he mark ‘FAST-FINDER’ with a hyphen (which mark is in legal contemplation substantially identical to the mark ‘FASTFINDER’ without a hyphen)...”).

Because of the significant commonality between the dominant portion of each mark, the marks overall look and sound similar regardless of the cited mark’s design element and Applicant’s mark’s inclusion of the descriptive word HEMP. We must consider the marks “in light of the fallibility of memory.” *See In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977)).

As to the marks' connotations and commercial impressions, we also find them to be similar. First, consumers would derive the same meaning and impression from the shared wording NATURES STAR/NATURES-STAR in Applicant's mark as they would in the cited mark. Nothing about the design in the cited mark changes the meaning of the common element, and it merely reinforces the reference to nature that is found in both marks. As discussed, the additional descriptive wording HEMP in Applicant's mark would be perceived merely as referring to the type of goods and is less significant in terms of meaning and impression. Thus, while HEMP adds some additional nuance to the meaning and impression of Applicant's mark, it does so only in that it conveys information about the goods, and therefore does not help consumers distinguish source. *See Detroit Athletic Co.*, 128 USPQ2d at 1050. The Examining Attorney also points out that hemp is a plant,⁵ and consumers familiar with one mark who encounter the other might presume that the plant depicted in the cited mark is the hemp referred to in the subject application.

Given the resemblance in sound, appearance, connotation and commercial impression when the marks are considered in their entirety, we find that Applicant's mark is similar to the cited mark, and the first *DuPont* factor weighs in favor of likely confusion.

⁵ We take judicial notice of the Merriam-Webster.com entry submitted by the Examining Attorney. 8 TTABVUE 19. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

B. Relatedness of the Goods

In analyzing the second *DuPont* factor, we look to the identifications in the application and cited registration. *See Detroit Ath. Co.*, 128 USPQ2d at 1051; *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). “[L]ikelihood of confusion can be found ‘if the respective goods are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Coach Servs.*, 101 USPQ2d at 1722 (internal citations omitted). It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any good encompassed by the identification in this single-class application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015), *aff’d*, 123 USPQ2d 1744.

The cited registration’s goods include essential oils, oils for toiletry purposes, and fragrances. Because Registrant’s goods are unrestricted, they are broad enough to include such products that contain hemp. Applicant’s goods are skin and body topical lotions, creams, balms⁶ and salves for cosmetic use that contain hemp oil extract as further specified in the identification. Hemp comes from the Cannabis plant, and may

⁶ A balm can be defined as an “aromatic salve or oil.” We take judicial notice of the American Heritage Dictionary entry for “balm” submitted by the Examining Attorney. 8 TTABVUE 18.

be cultivated for “edible seeds and oil,” but “is often distinguished from cannabis by possessing very low levels of the psychoactive substance THC.”⁷

We find the goods related because the record reflects that consumers are accustomed to encountering these types of products from the same source. Applicant itself serves as an example. The Examining Attorney introduced screenshots from Applicant’s website that show it offers under the MOOD FACTORY mark essential oils as well as balms.⁸ Other screenshots show Applicant offering under the SPA...AH mark massage oil, lotion and body butter cream.⁹ Applicant’s website includes “Smith & Vandiver CBD Collection Store,” and also directs consumers to “click” to “see our non-CBD products store.”¹⁰

In addition, numerous screenshots from various third-party websites show the promotion of goods like Applicant’s and Registrant’s under the same mark. Much of the evidence refers to “CBD,” which is “a nonintoxicating cannabinoid found in cannabis and hemp.”¹¹ Examples of third-party websites in the record include:

The A88CBD website offers essential oil and CBD Body Lotion, CBD Lip Balm, and CBD Muscle Salve, all under the A88CBD mark.¹²

The e.l.f. website offers a wide variety of goods under the e.l.f. mark, such as facial oils, including a CBD facial oil,

⁷ MERRIAM-WEBSTER DICTIONARY entry for “hemp” submitted by the Examining Attorney.

⁸ TTABVUE 19.

⁸ April 4, 2020 Office Action at TSDR 39 (svnaturally.com).

⁹ *Id.* at 23, 44-48.

¹⁰ *Id.* at 51.

¹¹ We take judicial notice of the Merriam-Webster Dictionary entry for “CBD,” accessed at merriam-webster.com on December 12, 2022.

¹² December 28, 2020 Office Action at TSDR 6-7 (a88cbd.com).

creams, including a CBD eye cream, and lotions. One webpage titled “CANNABIS SATIVA COLLECTION” features facial oil, cream, and balm, all under the e.l.f. mark.¹³

The Kiehl’s website offers under the KIEHL’S mark fragrances, oils, lotions, including a “Cannabis Sativa Seed Oil Herbal Concentrate Face Oil,” and a presumably non-hemp-based “Daily Reviving Concentrate Face Oil,” as well as a hand salve and various creams.¹⁴

The Pacifica website offers under its PACIFICA mark lotion and cream products, aromatherapy oil, and “Cosmic Hemp CBD Everything Balm.”¹⁵

The Plant Therapy website offers under the PLANT THERAPY and design mark a wide range of essential oils, creams, lotions, lip and healing balms, and a variety of “CBD PRODUCTS” that include day oils, night oils, body oils, and balms.¹⁶

The Root of It All’s website offers under the mark, THE ROOT OF IT ALL, offers “Cannabis-Infused Essential Oils,” as well as other types of essential oils.¹⁷

The website of Soul Purpose offers under the SOUL PURPOSE mark a variety of cosmetic products and fragrances, and features a line of “CBD Essentials” described as “Phytocannabinoid Rich Hemp Oil infused products” including creams, perfumes and oils.¹⁸

¹³ December 28, 2020 Office Action at TSDR 8-13 (elfcosmetics.com).

¹⁴ December 28, 2020 Office Action at TSDR 14-18 (kiehls.com).

¹⁵ December 28, 2020 Office Action at TSDR 19-23 (pacificabeauty.com).

¹⁶ December 28, 2020 Office Action at TSDR 24-34 (planttherapy.com); August 1, 2021 Office Action at TSDR 18-24 (planttherapy.com).

¹⁷ August 1, 2021 Office Action at TSDR 25-26 (rootusa.com).

¹⁸ August 1, 2021 Office Action at TSDR 27-31 (soulpurpose.com).

Swanson's website offers under the SWANSON mark various essential oils, as well as "CBD Hemp Extract" balm and oil.¹⁹

The Edens Garden website offers various oils, including hemp essential oil, as well as fragrances, all under the EDENS GARDEN mark.²⁰

The Hempz website states that it "offers a full spectrum of bath, body and haircare products that harness the natural restorative power of 100% PURE NATURAL HEMP SEED OIL."

The Green Flame website offers various hemp extract products, including essential oils.²¹

The website of Hemp Seed Natural Body Care offers under the HEMP SEED mark both body oils and lotions.²²

The Dancing Dingo website offers, under the DANCING DINGO mark, various fragrances and perfume oils as well as a "Patchouli and Hemp Perfume Oil" and a "Soothing Hemp Seed Oil Body Cream."²³

This evidence supports the relatedness of the goods in the application and cited registration by showing that consumers are accustomed to encountering them offered by a single source under the same mark. *See Detroit Ath. Co.*, 128 USPQ2d at 1050 (crediting relatedness evidence that third parties use the same mark for the goods and services at issue because "[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both"); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir.

¹⁹ August 1, 2021 Office action at TSDR 32-36 (swansonvitamins.com).

²⁰ April 4, 2020 Office Action at TSDR 5-8 (edensgarden.com).

²¹ April 4, 2020 Office Action at TSDR 9 (yourlivingessentials.com).

²² April 4, 2020 Office Action at TSDR 10-11 (hempseedbodycare.com).

²³ August 1, 2021 Office Action at TSDR 15-17 (dancingdingo.com).

2002) (stating that evidence that “a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis”).

While Applicant argues that the goods do not overlap, the issue here is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to their source or sponsorship. *See L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). Even when goods are not the same, where the evidence shows that consumers are used to encountering them from the same provider, they can be sufficiently related to “give rise to the mistaken belief that they emanate from the same source.” *See Coach Servs., Inc.*, 101 USPQ2d at 1722.

The second *DuPont* factor weighs in favor of likely confusion.

C. The Trade Channels and Classes of Consumers

Turning to the trade channels and classes of consumers, because the identifications in the application and cited registration have no restrictions on channels of trade, we must presume that the services travel in all normal channels of trade for such goods. *See Hewlett-Packard Co.*, 62 USPQ2d at 1005. The third-party website evidence discussed above shows that goods such as Applicant’s and Registrant’s move in some of the same channels of trade to some of the same classes of consumers.

Thus, the third *DuPont* factor weighs in favor of likely confusion.

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Decision: The similarity of the marks and relatedness of the goods, which travel in overlapping trade channels to some of the same consumers, renders confusion likely. The refusal to register based on likelihood of confusion is affirmed.